

### **Remarks/Arguments**

Upon entry of the present amendment, claims 7 and 8 remains in the application.

### **THE REJECTION**

In the above identified Office Action, the Examiner, after being reversed at the Board of Appeals, has re-opened prosecution citing U.S. Patent No. 4,316,290 as being anticipatory of the present invention as set forth in the claims.

### **THE REFERENCE**

The Montesi reference is aN ear muff accessory for a safety hard hat. According to the reference there is disposed and mounted onto a stud a pair of opposed washers 40 and 50 associated with each ear muff. Further, according to the reference:

“...the washer 40 comprises an inner surface 42 engaging the wall 32 of retainer 30, and opposite outer inclined cam surface 44 situated at an angle of from about 5° to 10°, preferably about 5°, from a plane normal to the axis of the pivot stud 28 passing through a central aperture of simple configuration therein.

The configuration of the central aperture in washer 40 is less than a complete circle defined by opposite internal straight sides or surfaces extending between ends of opposing ¼ round or partly circular internal arcuate surfaces of the washer 40.

The washer 50 is substantially identical to washer 40 rotated 180° therefrom.”

Moreover, according to the reference, the washer 40 is "...non-rotatable or stationary".

It is respectfully submitted that the Examiner's rejection is in error.

### **ARGUMENT**

As the Examiner will recall, this case went to the Board of Appeals where there was a reversal predicated on art which pertained to podiatric devices. Having been reversed, the Examiner has now gone further astray looking for and uncovering art which is so totally unrelated to the present invention as to be clearly non-analogous. As the Examiner is well aware, non-analogous art cannot be used to negate the patentability of an invention.

The Examiner, in attempting to sustain the rejection states: "all the functional claim language and statements of intended use do not make an otherwise unpatentable claim, patentable". However, the Examiner fails to point out what "functional" language in the claim she is addressing.

It certainly appears that the Examiner simply cannot abide by the patentability of the invention because of its simplicity. However, simplicity should not be the criteria by which to negate the patentability of an invention, especially, when the truly relevant art does not teach, disclose or suggest the invention set forth in the claims, as determined by the Board.

However, in order to expedite the prosecution of this application, claim 7 has been amended to further distinguish the structure from that shown in the reference. Claim 8 depends from claim 7 and includes the limitations thereof

and therefore is distinguishable from the art being applied here, as well.

Specifically, claim 7 now requires that the disc have a continuous upper surface and a continuous lower surface. This limitation differentiates the present invention from that shown in the reference and negates any concept of anticipation. Furthermore, it also negates any concept of obviousness for the reasons pointed out hereinafter.

In order to practice the Montesi reference, it is incumbent that there be a central, non-circular, aperture formed therewithin so that the washer can be mounted onto the stud. Absent this opening the washer thereof is inoperative.

In order for there to be an anticipation it is incumbent that each and every element of the invention, as claimed, be shown by the alleged anticipating reference. The reference, as pointed out above, clearly fails to teach a continuous upper and lower surface. Therefore, there can be no appropriate anticipatory rejection with respect hereto.

Moreover, the Montesi reference cannot render obvious the claims as amended. To allege Montesi is suggesting a continuous surface would be interposing the present invention as the means for denying the patentability, i.e. reconstructive hindsight. Furthermore, there is absolutely no suggestion in this reference to provide a washer with a continuous surface since it would destroy the operability and the purposes to which Montesi is directed. It is submitted that a washer without a central hole is not a washer.

Therefore, on all accounts the present invention, in view of the

amendment to the claims has now been rendered patentably distinct from the art of record.

It is respectfully submitted that by this amendment all bases of rejection have been traversed and overcome. The claims have been amended to render them patentably distinct from the art of record. Therefore, it is submitted that in the absence of more pertinent art that by this amendment the application has now been placed in condition for allowance and a notice to this effect is, therefore, respectfully requested.

If the Examiner feels that the prosecution of this application can be expedited then she is courteously requested to place a telephone call to applicant's attorney at the number listed below.

Respectfully Submitted,

  
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